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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/237,533 01/27/99 MARSHALL

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EXAMINER

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ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/237,533

Applicant(s)  
MARSHALL et al

Examiner  
Brenda Pham

Art Unit  
2664



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jul 6, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-13 and 21-25 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-13 and 21-25 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claims 1-13, 21-22, 24-25 have been examined.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 21-22, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by **Jones et al** (US Patent 5,978,013), hereinafter referred to as **Jones**.

-Regarding claims 1, 21, 24, and 25, **Jones** discloses a system for distributing packets of information to individuals at selected retail locations said system including:  
means (10, 12 and 24 of Fig 1) for creating packets of information in a digital format (video signal); a wireless network for transmitting packets of information to retail locations (20 of Fig. 1); and a network of printer appliances at locations (figure 3, 4, 7 show the receiving portion of the system at the television viewer's site), each of appliances being adapted to selectively receive, process and store said transmitted packets of information; and convert said packets of information into a printed format for distribution to said individuals.

-Regarding claims 2, 22, **Jones** teaches packets of information are redeemable retail coupons (98 of Fig. 3).

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-Regarding claim 3, **Jones** also teaches printer appliances further includes a sensor adapted to detect whether said printed packet has been removed from said appliance.

**Jones** teaches "The subscriber unit may keep track of the coupons printed and prevent the user from printing those coupons again.", (see abstract).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jones** et al (US Patent 5,978,013) in view of **Von Kohorn** (US Patent 5,249,044).

-Regarding claims 4 and 23, **Jones** does not teach means for printing an additional copy of said packet upon detection by said sensor that said printed packet has been removed from said appliance.

**Von Kohorn**, in the same field of endeavor, teaches system transmit a video image of product information, such as the manufacturer's name, the amount of the discount, and an identification number. The product information is displayed on a consumer's television. The consumer views this information on the television and then manually enters it into a hand-held electronic device using a keypad. The device has a printer that can be activated to print a coupon having some or all of the entered product information on it. The **Von Kohorn** system allows a

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user to print multiple copies of a coupon by entering the same product information multiple times. Another feature of the **Von Kohorn** system allows the electronic device to record the coupon transmission while the consumer is away from the television.

Therefore, it would have been obvious to one having ordinary skilled in the art at the time of the invention was made to modify the **Jones'** system with the teaching of **Von Kohorn** to allow a user to print multiple copies of a coupon if needed.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Jones** et al (US Patent 5,978,013) in view of **Wright** (US Patent 6,085,972).

-Regarding claim 13, **Jones** further fails to teach wherein said printer appliance further includes a motion detector to detect the presence of an individual in the immediate proximity of said appliance and means to display a stimulus upon the detection of the presence of said individual.

**Wright**, in the same field of endeavor, teaches this limitation.

**Wright** teaches "The motion detector 68 is provided to detect the presence of a user in the area proximate the retail terminal 10. In particular, when a user approaches the area proximate retail terminal 10, the motion detector 68 generates an output signal which is sent to the main controller board 22. The main controller board 22 may then cause a video and/or audio sequence to be executed on the display monitor 20 and/or the stereo speaker assembly 16, respectively, which draws the user's attention to the retail terminal 10. It should also be appreciated that the motion detector 68 may also be used to facilitate energy conservation by the retail terminal 10.", (see col. 9, lines 1-10).

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Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to implement a motion detector in **Jones** to detect the presence of a user in the area which draws the user's attention to the commercial program.

7. Claim 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable by **De Lapa et al** (US Patent 5,353,218), hereinafter referred to as **De Lapa**.

-Regarding claims 5, 6 and 9, **De Lapa** discloses a system for distributing packets of information to individuals at selected retail locations, said system including:

means (42 of Fig. 6) for creating said packets of information in digital format; means (112, 146 of Fig. 8a) for identifying intended recipients of said packets of information; a network (62 of Fig. 4) for transmitting packets of information to retail locations(89 of Fig. 5); and a network of printer appliances (82 of Fig. 5) at said locations, each of said appliances being adapted to: selectively receive, process and store said transmitted packets of information; and convert said packets of information into a printed format for distribution to said individuals, (see figure 5).

**De Lapa** teaches a method includes "A packet of coupons 43 is generated for each consumer in the data base (FIGS. 2 and 3). Each consumer is provided with a set of coupons that are selected for that consumer as a function of the data in a consumer master data base and a coupon data base...", (see col. 5, lines 64-67, col. 6, lines 1-25).

**De Lapa** further teach means for establishing a sequence of distribution of packets of information, (see col. 12, table 4, MAIL-SEQUENCE).

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Although **De Lapa** does not teach a wireless network, it is well known in the art to transmit digital packets of information via a wireless network by equipped with a wireless modem.

Wireless network offer a significant logistical advantage over wired networks by obviating the need to run wires or cables to each device.

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to utilized a wireless network for transmitting said packets of information to retail location.

-Regarding claim 7, **De Lapa** further teaches means for importing textual and graphic information relating to said packets.

**De Lapa** teaches "a newsletter, such as a multicolor offset printed 45, is included with each set of coupon sheet 44 and 44'. The purpose of the newsletter is in order to provide further information about the products discounted by the coupons, which may be included in the packet mailed to the particular consumer, as well as to provide information to the consumer that will further cause the consumer to value participating in the coupon program.", (see col. 6, lines 13-20).

-Regarding claim 8, **De Lapa** further teaches means for identifying includes a data base manager (Master data base 31) having a directory of all printer appliances and means for identifying those printer appliances to which each of said packets are intended to be distributed.

**De Lapa** teaches "Master data base 31 includes three files of records updated from member data base 25. A consumer Master Structure, such as that shown in Table 1, will hold the name, address and demographic data for each member...", (see col. 10, lines 65-67).

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8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable by **De Lapa et al** (US Patent 5,353,218) in view of **Rutledge** (US Patent 6,205,321).

-Regarding claim 10, **De Lapa** fails to teach wherein said wireless network comprises at least one wireless pager.

**Rutledge**, in the same field of endeavor, teaches this limitation, (see item 45 of Fig. 3).

**Rutledge** teaches that "Typically, the numeric or alphanumeric page message is stored in a memory within the paging receiver for later recall and display by the pager user. In order for the pager subscriber or user to be able to retrieve the pages or messages sent to the pager, however, the user must carry the pager within tactile proximity to his or herself. That is, if the user is without the pager, then the user will be unable to operate the pager, and therefore unable to retrieve any of the messages received by the pager. As a result, there is a need to allow a pager user to operate the pager from a remote location, without having to carry any additional hardware, so that pages received by the pager can be accessed therefrom.", (see col. 1, lines 23-34).

For the reason set forth by **Rutledge**, it would have been obvious to one skilled in the art at the time of the invention was made to implement at least one wireless pager in **De Lapa**.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable by **De Lapa et al** (US Patent 5,353,218), hereinafter referred to as **De Lapa**, in view of **Von Kohorn** (US Patent 5,249,044).

-Regarding claims 11 and 12, **De Lapa** fails to teach wherein said printer appliance further includes means for printing an additional copy of said packet upon detection by said sensor that said printed packet has been removed from said appliance.

**Von Kohorn**, in the same field of endeavor, teaches system transmit a video image of product information, such as the manufacturer's name, the amount of the discount, and an



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identification number. The product information is displayed on a consumer's television. The consumer views this information on the television and then manually enters it into a hand-held electronic device using a keypad. The device has a printer that can be activated to print a coupon having some or all of the entered product information on it. The **Von Kohorn** system allows a user to print multiple copies of a coupon by entering the same product information multiple times. Another feature of the **Von Kohorn** system allows the electronic device to record the coupon transmission while the consumer is away from the television.

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to modify the system of **De Lapa** with the teaching provide by **Von Kohorn** that allows a user to print multiple copies of a coupon.

### *Conclusion*

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-6743, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist)


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (703) 308-0148. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Brenda Pham  
July 26, 2001



WELLINGTON CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600